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OFFICE OF PETITIONS

In re Application of
PICCARIELLO et al.
Application No. 09/933,708
Filed: August 22, 2001
Attorney Docket Number:
54719.000028

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DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.78(a), filed June 17, 2004, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to prior-filed nonprovisional Application no. 09/642,820, and to accept unintentionally delayed priority claims under 35 U.S.C. § 119(e) to the provisional applications indicated on the accompanying amendment¹.

The petition is granted.

RE: CLAIM FOR PRIORITY UNDER 1.78(a) (3)

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

¹ The instant amendment corrects the benefit claims submitted in the preliminary amendment filed December 26, 2001 by: 1) removing the reference under 35 U.S.C. 120 to the provisional applications and 2) correcting errors in the application numbers of two of the provisional applications. With respect to the latter correction, correction of the application number from "60/278,672" to "60/248,672" appears to be in error as the preliminary amendment filed December 26, 2001 identified provisional application No. 60/248,672 at page 3, col. 5 thereof.

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed on August 22, 2001, and was pending at the time of the filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii). This amendment was filed with this petition on June 17, 2004. The petition includes payment of the surcharge under § 1.17(t). Petitioner states that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(2) and the date the claim was filed was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed application was submitted during the pendency of the instant nonprovisional application. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

RE: CLAIM FOR PRIORITY UNDER 1.78(a)(6)

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii), and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (i) the reference required by 35 U.S.C. § 119(e) and

37 CFR 1.78(a)(5)(i) to the prior-filed provisional application, unless previously submitted;

- (ii) the surcharge set forth in § 1.17(t); and
- (iii) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on August 22, 2001, within twelve months of the filing date of the prior-filed provisional applications, identified in the amendment filed June 17, 2004, for which priority is claimed. A reference to the prior-filed provisional applications has been included in an amendment to the first sentence of the specification following the title. The petition includes a statement of unintentional delay which is being construed as a statement that "the entire delay in filing the claim for benefit of priority under 35 U.S.C. § 119(e) (and § 120) was unintentional." Petitioner must notify the Office if this is not a correct interpretation of their statement. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 119(e) to the above-noted, prior-filed provisional applications satisfies the conditions of 37 CFR 1.78(a)(6), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application(s) under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application(s). In order for the instant application to be entitled to the benefit of the prior-filed application(s), all other requirements under 35 U.S.C. §§ 120 and 37 CFR 1.78(a)(1), and (a)(2) and (a)(5) and under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. The examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

This application is being forwarded to Technology Center Art Unit 1654 for consideration by the Examiner of applicant's claim under 35 U.S.C. §§ 120 and 37 CFR 1.78(a)(2) for the benefit of priority to the prior-filed application and for consideration of

the claims under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional applications.

The amendment filed June 17, 2004 will be reviewed by the examiner for compliance with 37 CFR 1.121.

Petitioner is advised that the instant application had reached the maximum capacity of 400 continuity records listed on a filing receipt. Thus, no further entries could be shown on the filing receipt without deleting an entry. An updated filing receipt is enclosed, which includes the applications that were specifically identified as being in error in the instant petition (application Nos. 09/642,820, 60/247,622 and 60/248,672).

Telephone inquiries concerning this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

A handwritten signature in cursive script, reading "Charles A. Pearson". The signature is written in dark ink and is positioned above the printed name and title.

Charles A. Pearson
Director
Office of Petitions

Enclosure: Updated Filing Receipt (9 pages)